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| 10/755,462 | 01/13/2004 | Makoto Shiokawa | 107355-00103 | 9927 |

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| EXAMINER |
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MILLER, DANIEL H

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| ART UNIT | PAPER NUMBER |
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1775

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,462

Applicant(s)

SHIOKAWA ET AL.

Examiner

Daniel Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/06/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 4-7, drawn to a carbonaceous molding, classified in class 428, subclass 698.
 - II. Claims 2-3 and 8-11, drawn to a method of making a carbonaceous molding, classified in class 427, subclass 249.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case product can be made using a materially different method. For instance, the metal carbide layer can be made separately and sintered to the carbon base material.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Charles Marmelstein on 5/08/2006 a provisional election was made with traverse to prosecute the invention of group I, claims 1 and 4-7. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 2-3 and 8-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. It is not clear what the ratio is meant to represent. Does the applicant mean the ratio of metal in the particular layer or some other ratio, based on all of the composite substances present?

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rousseau et al (U.S. 4,863,773).

11. Rousseau teaches a substrate with carbon fibers coated in silicon carbide and then coated in a (vitreous material) borosilicate glass (abstract). The silicon carbide layer has wedge like cracks (figure 1) moving from the surface of the layer to the carbon fiber based substrate. The outer silicon carbide coating appears to be all silicon carbide by weight. The silicon carbide coating is at most 600 micrometers (column 3 line 15-20), which is a range from 0-600 micrometer, which overlaps applicants claimed thickness. There is no evidence of diffusion and the process is similar to applicants disposed layer. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113)

12. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Skowronski et al (U.S. 5,955,197).

13. Skowronski teaches a carbon composite with a first layer of silicon carbide and a second Silicon dioxide glass layer (abstract). The second layer of glassy substance seals the cracks in the SiC layer (column 2 line 50-53). The material would inherently have wedge shaped cracks as described by applicant given the similarity of the material and exposure to similarly environmental conditions. The silicon carbide layer is between 1 and 250 micrometers, overlapping applicant's claimed range.

14. Claim 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kung (U.S. 5,418,012).

15. Kung teaches a multilayer coating system with a SiC substrate. The multilayer coating is a chromium carbide layer (column 10 line 15-60) with cracks that are coated and filled by glassy SiO₂ (column 9 line 50-65). The cracks can be vertical or horizontal and go up to the end of the layer and are considered to be wedge (see figure 5). The layer has a weight ratio as claimed by applicant (column 10 line 15-40). The thickness of the layer is approximately 20 micrometers, within applicant's claimed range.

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16. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Oguri (EP1188731).

17. Oguri teaches a carbon composite substrate having a SiC layer applied to the top and a glass material applied to the top of the SiC layer to seal cracks [006, 044]. The SiC laer (intermediate layer) has a thickness between 5 and 200 micrometers, which is an overlapping range [0035]. The SiC coating would inherently have a ratio of metal carbide of greater than 65%, since the layer is silent as to containing anything else.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rousseau et al (U.S. 4,863,773) or Skowronski et al (U.S. 5,955,197) or Oguri (EP1188731) or Kung (U.S. 5,418,012).

The references, as taught above and the claims differ in that they do not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the cited references overlap the instantly claimed proportions and

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therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Miller whose telephone number is (571) 272-1534. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel Miller



JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
5/30/06